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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/689,230
Filing Date: October 20, 2003
Appellant(s): EBERT, DAVID A.

Theodore W. Olds
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/6/06 appealing from the Office action mailed 3/5/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5.797,422	Tokarz	08-1998
2,105,617	Shaw	01-1938
1,829,365	Meyer	10-1931

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,797,422 to Tokarz.

Tokarz '422 teaches Applicant's claim limitations for a lever including : a "shank" - including 20, a "handle" - including 22, where the written Background of the Invention indicates that decorative materials including porcelain or clear plastic (inherent fragility well known) are used for the handle portion where one of ordinary skill in the art recognizes that shank portion is likely to be chrome-plated brass for example.

As regards claim 5, see Fig 4 for example.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz.

While Tokarz '422 does not explicitly disclose a "crystal material" for example, the handle material is explicitly disclosed to be "decorative" where one of ordinary skill in the art recognizes that "crystal" glass, or quartz crystal, jade, etc. handles would be decorative and applicable with respect to the teachings of Tokarz '422. One of ordinary

skill in the art would have found it obvious at the time of the invention to use a "crystal material" for the handle 22 of Tokarz '422 to appeal to various buyer market groups. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect function of the device but is entirely consistent with the explicit and implicit teachings of the reference. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

3. Claims 3, 4, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view of U.S. Pat. No. 2,105,617 to Shaw.

While the arrangement at 46,48 of Tokarz '422 might be assumed to be a single piece, head of the bolt, Shaw '617 teaches that it is well known in the art to provide a separate cap (41) to cover a bolt used to attach a handle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separate cap for covering the bolt of Tokarz '422, as modified to ensure that no aesthetically unwanted screw slots, etc are visible. One of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification.

As regards claim 4, a cross section through the handle at 40 (42 in Fig 4) fully anticipates limitation especially noting that a cross-section of the bore in that area will be perpendicular to the handle's longitudinal axis whereby due to inherent geometry,

the area of the "donut" shape cross section of the handle abutting the shank will be considerably more than twice the area of the circle-shaped bore.

As regards claim 10, Shaw '617, as relied upon specifically teaches threads on the cap member for threaded attachment to the bolt whereby the handle is held in compression. It's noted that embodiment of Tokarz '422 relied upon as base reference also teaches a bolt holding the handle in compression whereby one of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view of U.S. Pat. No. 1,829,365 to Meyer.

Although Tokarz '422 discloses a "shallow pocket" in the shank for receiving the handle portion, it is not particularly clear if there is an angle to that portion or not whereby it is not clear that "frusto-conical" limitation is taught. However, Meyer '365 discloses a similar shank/handle structure and explicitly illustrates a frusto-conical shallow pocket in the shank for receiving a correspondingly-shaped handle portion in Fig 1. It would have been an obvious design choice or engineering expedient to one of ordinary skill in the art to provide the handle/shank of Tokarz '422 with a frusto-conical shaped shallow pocket as taught by Meyer '365 in order to reduce any minor wobblieness resulting from manufacturing tolerances where it is well known in the art that tapered connection can take-up for dimensional tolerances.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view of U.S. Pat. No. 1,829,365 to Meyer and further in view of U.S. Pat. No. 2,105,617 to Shaw.

While the arrangement at 46,48 of Tokarz '422 (as modified in view of Meyer '365) might be assumed to be a single piece, head of the bolt, Shaw '617 teaches that it is well known in the art to provide a separate cap (41) to cover a bolt used to attach a handle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separate cap for covering the bolt of Tokarz '422, as modified to ensure that no aesthetically unwanted screw slots, etc are visible. One of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification.

6. Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view U.S. Pat. No. 2,105,617 to Shaw and further in view of U.S. Pat. No. 1,829,365 to Meyer .

While the arrangement at 46,48 of Tokarz '422 might be assumed to be a single piece, head of the bolt, Shaw '617 teaches that it is well known in the art to provide a separate cap (41) to cover a bolt used to attach a handle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separate cap for covering the bolt of Tokarz '422, as modified to ensure that no aesthetically unwanted screw slots, etc are visible. One of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification. And while the

cap of Shaw '617 is shown to have an angled handle-contacting surface defining a frusto-conical shaped surface, and is shown to contact a wall portion of the handle, it is not clear that the handle's contacting surface is angled. However, it would have been obvious to one of ordinary skill in the art in full consideration of the three references (relied upon) to provide the handle, shank, and cap of Tokarz '422, as modified in view of Shaw '617 with corresponding *angled* surfaces defining a frusto-conical shape as taught by Meyer '365 (where handle 13 engages in shallow pocket of part 12) for the purpose of taking up tolerance as well known to one of ordinary skill in the art.

(10) Response to Argument

(claims 1 and 5)

Arguments against rejection of claims 1 and 5 under 35 USC 102 are related to intended use of the claimed handle with an unclaimed door and are not persuasive. Arguments that an unclaimed door is referred to in the body of the claim, are noted but the unclaimed door is clearly only referred to *functionally* as part of some *intended use* and is not positively recited as part of the invention. See MPEP 2114. The invention is a product, defined by its structure where it's well-accepted that the manner in which a claimed apparatus is *intended* to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regardless, there is sound basis for one of ordinary skill to recognize that the structure of the prior art is inherently capable of use with a door due to the identicalness in form and function of a shaft of a faucet that is in use, intended to be turned by human hand via a lever and the shaft of a door latch that that is in use, intended to turned by human hand via lever. Contrary to arguments, a handle/lever that is attached to a faucet does not move the flow of water, it is used to provide an operator with means to grip and the leverage required to turn a shaft, in the same way that a handle/lever that is attached to a door latch is used to provide an operator with means to grip and the leverage required to turn a shaft. While not relied upon in grounds of rejection, one of ordinary skill in the art is presumed to be aware of other prior art such as U.S. Pat. No. 4,998,321 to Gaffney, which discloses at col 4; lines 1-4 that it is well known in the art of handle/levers that use of same on either of a door or faucet is well known in the art. It is the examiner's finding that the prior art is replete with handle/levers that may be used on either of a door or a faucet.

However, the determination of patentability of the claimed invention does not rest on whether or not it would have been obvious for someone to actually mount the handle/lever of the prior art on a door since combination with a door is not claimed as the invention.

Further argument that the Tokarz '422 reference does not anticipate the "more fragile" limitation of claim 1 is not persuasive since Tokarz '422 lists some of the desirable

materials for lever handles that are known in the art at col 1 lines; 29-32. Those desirable materials include wood, plastic, porcelain, clear plastic, etc.. The main inventive concept of the Tokarz '422 reference is to provide structure to allow handle/levers of at least those decorative materials to be alternatively attached to the same shank, as an improvement to replacement of the entire assembly so as to affect a decorative change in materials of the handle/lever. Cross-section illustration of the Tokarz '422 shank in Fig 4 for example explicitly uses the art-accepted cross-hatch pattern corresponding to metal. Regardless, one of ordinary skill in the art should readily acknowledge that handle/lever shanks are very commonly made from metal based on real-life experience, explicit disclosures of the prior art, and underlying knowledge that operational stresses are most concentrated at the shank. Accordingly, one of ordinary skill in the art should also recognize that the alternative materials of the handle/lever portion such as wood, plastic, porcelain, clear plastic are inherently "more fragile" than the material of the shank.

(claim 2)

Applicant concedes that rejection of claim 2 under 35 USC 103 stands or falls based on issues argued with respect to claim 1.

(claims 3 and 7)

Argument that modification of Tokarz '422 in view of Shaw '617 would destroy the reference are not persuasive since the modified handle/lever of Tokarz '422 would

preserve function of changeability of the material of the handle relative the shank without need to replace the entire assembly. Otherwise arguments related to what is aesthetically pleasing should be recognized as subjective inasmuch as one person might appreciate seeing nuts and bolts with faux or authentic rust/corrosion finishes, another might not. The rejection is motivated by desire well known in the art, to disguise or otherwise cover fasteners for sake of aesthetics. The structure for doing so is also explicitly disclosed by prior art such as Shaw '617.

(claim 4)

Contrary to arguments, the grounds of rejection does not admit that Tokarz '422 cannot meet the limitation. Limitation that the "central bore in said handle has a cross-sectional area that is less than half of the cross-sectional area of a portion of said handle that abuts said end face of said shank" is illustrated by the reference. The reference discloses a central bore in said handle having a large diameter portion (at its right side as shown in Fig 4) and a smaller diameter portion (at its left side in Fig 4). The reference also illustrates a "portion of said handle that abuts said end face of said shank" (at the generally right side of the handle as shown in Fig 4). Based on what is explicitly shown by the prior art and fundamental geometry calculations of the cross-sectional areas of the bore at the left end and the abutting face at the right end, the prior art anticipates limitation. Applicant argues that choice of where (along the longitudinal axis of the handle) the reference's central bore cross-sectional area was evaluated is arbitrary but does not argue why the claim must be interpreted more specifically so as to

prohibit that very selection. It is examiner's position that the scope of the limitation must be properly interpreted during its examination and is in fact, broad enough to include the selection of where (along the longitudinal axis) the cross-sectional area of the central bore is evaluated. Consequently, the rejection is proper. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

(claim 6)

Applicant concedes that rejection of claim 6 under 35 USC 103 stands or falls based on issues argued with respect to rejection of claim 1.

(claims 8 and 9)

Applicant argues that patentability of claims 8 and 9 stands or falls with respect to issues argued with respect to the rejection made under 35 USC 103 over disclosure of Tokarz '422 in view of teachings of Shaw '617 as argued above with respect to claim 4.

(claim 10)

Argument that the handle of Tokarz '422 is not held in compression is not persuasive. It seems clear that tightening the central bolt (Fig 4) of Tokarz '422 will inherently increasingly compress the material of the handle lever. The handle of Shaw '617 is relied upon for its teaching of a cap threaded onto the bolt. The cap of Shaw '617 is shown to be in contact with the material of the handle about its periphery whereby tightening the cap of Shaw '617 (Fig 1) will inherently increasingly compress the material of the handle. Consequently, it is the examiner's position that tightening the cap of the handle of Tokarz '422, as modified in view of Shaw '617, would inherently increasingly compress the material of the handle.

(claim 11)

Argument that the handle of Tokarz '422 is not held in compression is not persuasive. It seems clear that tightening the central bolt (Fig 4) of Tokarz '422 will inherently increasingly compress the material of the handle lever. The handle of Shaw '617 is relied upon for its teaching of a cap threaded onto the bolt. The cap of Shaw '617 is shown to be in contact with the material of the handle about its periphery whereby tightening the cap of Shaw '617 (Fig 1) will inherently increasingly compress the material of the handle. Consequently, it is the examiner's position that tightening the cap of the handle of Tokarz '422, as modified in view of Shaw '617, would inherently increasingly compress the material of the handle.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

GARY ESTREMSKY
PRIMARY EXAMINER

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